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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,803	12/19/2000	Gary R. McLuen	NET-00104	7285
28960	7590	11/16/2004		
HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086				
			EXAMINER HANDY, DWAYNE K	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/742,803

Applicant(s)

MCLUEN ET AL.

Examiner

Dwayne K Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27-30,35-38,40,42 and 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-30,35-38,40,42 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10182004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 27-30, 35-38, 40, 42 and 44 were previously rejected under 35 U.S.C. 102(b) as being anticipated by McGraw et al. (5,368,823). This rejection remains in effect. See Response to Arguments below.

### ***Response to Arguments***

3. Applicant's arguments, filed 8/30/2004, with respect to the Double Patenting rejection, the 112 rejections, and the 102 rejection involving "Chandler" have been fully considered and are persuasive. The rejections of all claims involved in these rejections have been withdrawn.
4. Applicant's arguments filed 8/30/2004 with respect to the 102 rejection involving the "McGraw" reference have been fully considered but they are not persuasive. In traversing the rejection made by the previous Examiner applicant appears to be relying on two main arguments: (1) The columns of McGraw do not maintain a consistent flow; (2) McGraw does not teach the retaining of the solid support after flushing the container;

and (3) McGraw does not teach a vial that is sized to form a pressure tight seal between the vial and cartridge. The Examiner respectfully disagrees with all three assertions.

In arguing the previous 112 rejections, applicant stated that consistent flow is achieved when "a similar reagent is used within two vials, the flow through the vials of the reagent will be consistent". The Examiner believes this feature is met by McGraw. McGraw teaches the addition of the same reactants to each column and utilizes the same vacuum (22) to draw those reactants through the columns and into the exit basin (17). Given these teachings, the Examiner believes McGraw teaches a consistent flow through the columns as required by the instant claims. As for the retaining of the solid support, the Examiner directs applicant to the synthesis procedure(s) disclosed in columns 7-11 – especially column 11. In column 11, McGraw describes the synthesis routine shown in Figure 8. In this routine, the columns are filled with reactant, drained (by vacuum) and washed multiple times with the solid support remaining in the synthesis column. In column 11, lines 62-68, McGraw recites the removal of the support from the synthesis column AFTER the multiple reactant adding/washing steps. Therefore, it is clear that the synthesis support is retained in the vial during the flushing of compounds through the column. As for the exterior of the vial being dimensioned to fit into a cartridge, the Examiner directs applicant to Figures 4, 5, and 7 which show the columns in holes of the exit basin (17).

**Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cargill et al. (5,609,826) and Young (6,537,504) teach reaction blocks that use solid supports in reactors when synthesizing compounds.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH  
November 12, 2004

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700